

REMARKS

The Official Action mailed December 1, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on August 30, 1999; April 26, 2001; March 5, 2002; and April 12, 2002.

The Applicant notes the partial consideration of the Information Disclosure Statement filed on September 8, 2005 (received by OIPE September 12, 2005). Specifically, it appears that the Examiner inadvertently overlooked the citation of "International Search Report dated 06/30/2005 for EP05012260.5" in the "OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS" section of the Form PTO-1449. The International Search Report appears in the Image File Wrapper (IFW) as "09/12/2005 NPL Documents PRIOR ART 3." As a courtesy to the Examiner, the Applicant has attached a copy of the partially considered Form PTO-1449 from the Information Disclosure Statement filed September 8, 2005 (received by OIPE September 12, 2005), signed by the Examiner on November 17, 2005, and attached to the Official Action mailed December 1, 2005. The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the International Search Report.

Also, the Applicant has not received acknowledgment of the Information Disclosure Statement filed on November 18, 2005 (received by OIPE November 22, 2005). The above-referenced Information Disclosure Statement appears in IFW.

Further, an Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

The Applicant respectfully requests that the Examiner provide initialed copies of the Form PTO-1449s evidencing consideration of the above-referenced Information Disclosure Statements.

Claims 7-26 are pending in the present application, of which claims 7, 11, 15, 19 and 23 are independent. The independent claims have been amended to better recite the features of the present invention, and dependent claim 9 has been amended as noted above in order to correct a minor typographical informality. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 4 of the Official Action rejects claims 7-26 as obvious based on the combination of U.S. Patent No. 6,586,874 to Komoto et al. and U.S. Patent No. 6,281,867 to Kurematsu et al. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 7, 11, 15, 19 and 23 have been amended to recite a color filter adjacent to a counter substrate, which is supported in the present specification, for example, by page 10, lines 15-21 and Figures 4(D) and 4(E). For the reasons provided below, Komoto and Kurematsu, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Official Action asserts that the substrate 32 (Figure 16, reproduced below) and the Fresnel type reflection plate 200 (Figure 39, reproduced below) of Komoto correspond with the active matrix substrate and the counter substrate, respectively, of the independent claims of the present application. Fresnel type reflection plate 200 is relied upon in order to allegedly teach that light emitted from a light source is introduced into a panel from a side of the counter substrate. It is noted that the Official Action has not shown how one of ordinary skill in the art would have combined the Fresnel type reflection plate 200 into the device shown in Figure 16. However, due to the orientation of the viewer (depicted with an eye in both Figures), the Fresnel type reflection plate 200 would have to be used with light guiding plate 26 of Figure 16. That is, Fresnel type reflection plate 200 would be placed in a lower portion of the device shown in Figure 16.

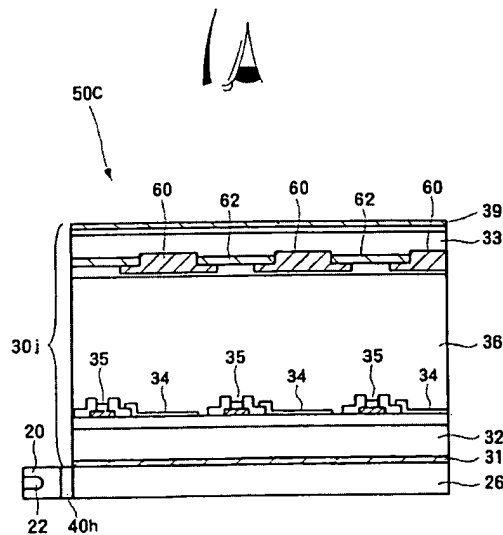


FIG. 16

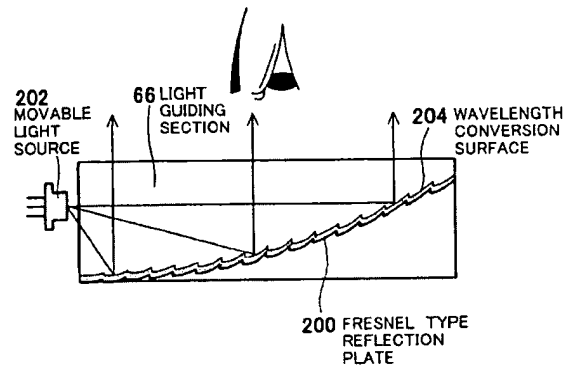


FIG. 39

Komoto does not teach or suggest that Fresnel type reflection plate 200 should be used with the upper portion of the device shown in Figure 16. The color filter 60 of Komoto is associated with the upper portion of the device shown in Figure 16. Komoto does not teach or suggest that color filter 60 could or should be adjacent to Fresnel type reflection plate 200. Therefore, Komoto does not teach or suggest a color filter adjacent to a counter substrate.

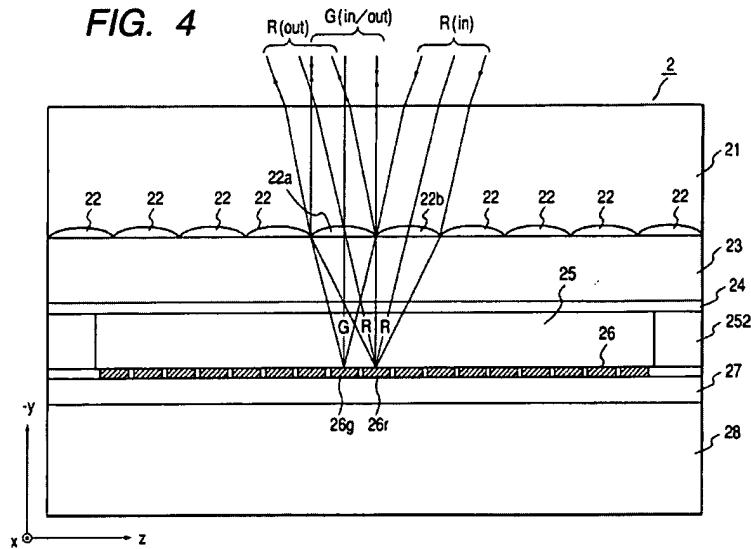
Kurematsu does not cure the deficiencies in Komoto. Kurematsu is relied upon to allegedly teach that "at least a part of the white light introduced to said counter substrate is reflected on the pixel electrode so as not to pass through the active matrix substrate" (page 4, Paper No. 20051117). Komoto and Kurematsu, either alone or in combination, do not teach or suggest a color filter adjacent to a counter substrate, where light emitted from a light source is introduced into a panel from a side of the counter substrate, or that color filter 60 of Komoto could or should be adjacent to Fresnel type reflection plate 200.

Since Komoto and Kurematsu do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Furthermore, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Komoto and Kurematsu or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references “could have been” combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

Figure 16 of Komoto teaches a color filter 60 in an upper portion of the device. However, Figure 4 of Kurematsu teaches away from providing a color filter in an upper portion of a device (column 1, lines 28-35). Specifically, Figure 4 of Kurematsu (reproduced below) is relied upon to allegedly teach that “at least a part of the white light introduced to said counter substrate is reflected on the pixel electrode so as not to pass through the active matrix substrate” and teaches that color filters should be provided in a lower portion of the device.



Also Figure 4 of Kurematsu is provided as an improvement over a device such as that shown in Figure 13 of Kurematsu, where color filters are provided in an upper portion of a device. As such, it would not have been obvious to one of ordinary skill in the art to combine the device shown in Figure 16 of Komoto (color filters in an upper portion of the device) with the device shown in Figure 4 of Kurematsu (color filters in a lower portion of the device).

Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Komoto and Kurematsu or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

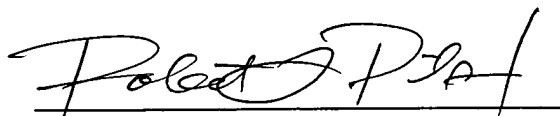
For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Paragraph 10 of the Official Action rejects claims 7, 11, 15, 19 and 23 as obvious based on the combination of Komoto and U.S. Patent No. 5,926,240 to Hirota et al.

Please incorporate the arguments above with respect to the deficiencies in Komoto. Hirota does not cure the deficiencies in Komoto. The Official Action relies on Hirota to allegedly teach that "at least a part of the white light introduced to said counter substrate is reflected on the pixel electrode so as not to pass through the active matrix substrate" (page 7, Paper No. 20051117). However, Komoto and Hirota, either alone or in combination, do not teach or suggest a color filter adjacent to a counter substrate or that color filter 60 of Komoto could or should be adjacent to Fresnel type reflection plate 200. Since Komoto and Hirota do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert L. Pilaud", written over a horizontal line.

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